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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,653	09/29/2003	Donald May	87838.0008	2355
33135	7590	04/08/2004	EXAMINER	
STEPTOE & JOHNSON LLP 201 EAST WASHINGTON STREET SUITE 1600 PHOENIX, AZ 85004			SALDANO, LISA M	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/673,653

**Applicant(s)**

MAY, DONALD

**Examiner**

Lisa M. Saldano

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/29/2003
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 1, 4 and 8 are objected to because of the following informalities:

Regarding claim 1, line 3, the applicant recites limitations regarding "said pier shaft." Prior language fails to recite "a pier shaft." It is suggested that the applicant provide antecedent basis for the term "pier shaft" or change the claim language to state *pier's shaft*.

Regarding claim 4, line 4, the applicant recites limitations regarding "a shelf mounted to the side of said tube." Prior claim language already claims a shelf in the invention. It is suggested that the applicant provide proper language to differentiate the two shelves if they comprise different elements of the invention. Please clarify.

Regarding claim 8, line 3, the applicant recites limitations regarding a "weight bearing layer of earth." It appears that the applicant intended to claim a weight *bearing* layer of earth. Please clarify.

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6, 8, 9 and 11-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 6, 10, 13, 14 and 17 of U.S. Patent No. 6,659,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose essentially the same subject matter aside from slight difference in wording.

Regarding claims 1, 5, 8, 9, 11, 16 and 18, May discloses a helical pier or a pier, which is inherently driven into earth, located adjacent a footer because it supports the footer of a foundation. May further discloses a pier cap stabilizer, shelf and screw jack as recited by the applicant of the present application. May further discloses gusset mounted on the shelf (see patented claims 1, 4 and 10). The shelf inherently comprises a plate.

Specifically, in the case of claim 8, the applicant has claimed a pier in the present application. The pier cap stabilizer of patented case may be considered at part of the overall pier since after installation, it works in combination with pier shaft 6 to support the footer of a foundation.

Regarding claim 2, May discloses a helical pier, which inherently comprises a helix in the bottom end of the pier (see patented claims 1 & 4).

Regarding claim 3, May discloses a flexible bag containing structural material (see patented claim 2).

Regarding claims 4, 12-14 and 19, May discloses a pier, which is inherently driven into earth, located adjacent a footer because it supports the footer of a foundation. May further discloses a pier cap stabilizer, shelf and screw jack as recited by the applicant of the present application. May discloses a bolt, which functions as a pin. The pier cap stabilizer comprises a tube as well (see patented claims 10 & 17).

Regarding claim 6, May discloses a pin mounted to the stabilizer (see patented claim 6).

Regarding claims 8, 15 and 17, May discloses a shelf that is rotatable with respect to the footer (see patented claims 10 & 14). May further discloses a notch in the footer of the foundation (see patented claims 13).

4. Claims 7 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 6,659,692 in view of Thornley (2,465,557).

May discloses a pier, which is inherently driven into earth, located adjacent a footer because it supports the footer of a foundation. May further discloses a pier cap stabilizer, shelf and screw jack as recited by the applicant of the present application. May further discloses gusset mounted on the shelf (see patented claim 10). The shelf inherently comprises a plate.

However, May fails to disclose that a pier cap is mounted to the bottom end of the pier.

Thornley discloses a pile and method of making the same. Thornley discloses that the pile comprising shell 1 is driven with a concrete plug 2 mounted to the bottom end of the shell

(see Figs. 1-3). Thornley discloses that the method of driving the pile with the concrete plug provides for the driving force to be focused primarily on the plug, minimizing force, especially frictional resistance, on the pile itself during driving (see columns 5 and 6). This method reduces the likelihood of distortion of the shell or pile. The pile is ultimately placed upon a firm subterranean stratum for structural support (see claim 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the pier as described in patented claim 10 to comprise a pier cap at the bottom end, as suggested by Thornley because the pier cap provides for reduction of frictional resistance on the pier during the pier driving process, as suggested by Thornley.

5. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 10 and 14 of U.S. Patent No. 6,659,692 in view of Grzelka et al (4,538,938).

May discloses a pier, which is inherently driven into earth, located adjacent a footer. The pier supports the footer of a foundation. May further discloses a pier cap stabilizer, shelf and screw jack as recited by the applicant of the present application. May further discloses gusset mounted on the shelf (see patented claim 10). The shelf inherently comprises a plate.

However, May fails to disclose a screw jack guide to locate the screw jack assembly on the invention.

Grzelka et al disclose an adjustable chock system for use on a jack-up rig comprising screw jacks 50. The screw jacks are located on a working platform 12 (see Fig.4). Grzelka et al

disclose a guide track 52 to guide the screw jacks on the working platform (see column 2, lines 50-55). The guides help to retain the screw jacks in a desired orientation.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the pier assembly of May comprising screw jacks to include guides, as suggested by Grzelka et al, because it assists in proper location of the screw jacks relative to the rest of the inventions and assists to securely operate the screw jacks when jacking the pier cap stabilizer up against the foundation footing.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman, III (5,336,021).

Regarding claim 15, Freeman, III discloses a system for underpinning a building comprising a pier 59; a shelf 97 rotatably mounted to the pier 59 through body 83; and a screw jack assembly comprising screw bolts (77,79) and jacks 99 that extends from shelf 97 to the bottom of foundation footing 5 (see Fig.7).

Regarding claim 17, Freeman's pier 59 is positioned vertically next to the footing 5.

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Regarding claim 18, Freeman's overall bracket 81 functions as a pier cap stabilizing shaft that is mounted to pier 59. Shelf 97 is mounted to the pie.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa M. Saldano whose telephone number is 703-605-1167. The examiner can normally be reached on Monday-Friday, 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on 703-308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lms

  
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